



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/830,172	04/21/2004	Ralf Schliephacke	101769-254 (tcsa AG 1635)	8156
27384 7590 03/20/2007 NORRIS, MCLAUGHLIN & MARCUS, PA 875 THIRD AVENUE 18TH FLOOR NEW YORK, NY 10022			EXAMINER SELLS, JAMES D	
			ART UNIT	PAPER NUMBER
			1734	

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	03/20/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/830,172

Applicant(s)

SCHLIEPHACKE ET AL.

Examiner

James Sells

Art Unit

1734

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 December 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hoffmann (US Patent 5,562,789) in view of Treleaven (US Patent 6,413,345).

Hoffmann discloses a method of making a label. As shown in Figs. 7-11, the method provides web 111 with release liner ply 116, silicone coating 118, pressure sensitive adhesive 120 and a plurality of labels 122 surrounded by die cuts 123 in the manner claimed by the applicant.

However, Hoffmann does not disclose the die cut line configuration as claimed by the applicant. Regarding this difference, the applicant is directed to the reference of Treleaven.

Treleaven discloses a method for making labels. This method employs die cut station 30 to for tear lines 135A, 135B, 155A, 155B and 158 in the labels. In particular, Figs. 2 shows the tear lines with a saw-toothed configuration.

3. It would have been obvious to one having ordinary skill in the art to employ a saw-toothed tear line, as taught by Treleaven, in the method of Hoffmann as a matter of design choice based on desired physical properties and appearance of the labels being produced. In addition, it is the examiner's position that employing an anti-adhesive

coating on both sides of a backing material is well known and conventional in the art in order stack the materials without damaging them. For this reason, it would have been obvious to one having ordinary skill in the art to employ an anti-adhesive coating on both sides of a backing material in the method of Hoffmann in view of Treleaven as described above.

Response to Arguments

4. Applicant's arguments filed December 21, 2006 have been fully considered but they are not persuasive.

Applicant argues that a claim need not recite the improved properties of a product so long as the structural features which are responsible for the improved properties are recited in the claim. First, applicant's claims are directed to a method, not a product. Second, the examiner does not believe applicant's claims recite any improved properties. Therefore applicant's argument is believed to be irrelevant in this instance.

Applicant argues the invention has the surprising effect of increasing the speed with which the diecuts can be applied. In particular, applicant's undular diecut of the present invention can be dispensed at a maximum rate of 2.0 m/s while straight-line diecuts of the prior art can only be dispensed at a maximum rate of 0.3 m/s. However, it is the examiner's position that applicant's claims do not contain any limitations concerning the speed with which diecuts can be applied. *As an example for illustrative purposes only*, if the prior art dispensed undular diecuts at a slower rate of 0.1 m/s, it would meet the limitations of applicant's claims because it shows all of the

Art Unit: 1734

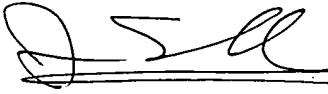
steps recited in the claims. There are no limitations in applicant's claims that require a higher dispensing rate as asserted by applicant. Therefore applicant's argument is believed to be irrelevant in this instance.

In response to applicant's argument that there is nothing in Hoffmann and Treleven that teaches or suggests that use of an undular diecut form as opposed to a straight-line diecut form should increase the speed of application of the diecuts, the fact that applicant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985).

Telephone/Fax

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to James Sells whose telephone number is (571) 272-1237. The examiner can normally be reached on Monday-Friday between 9:30 AM and 6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chris Fiorilla can be reached at (571) 272-1187. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.


JAMES SELLS
PRIMARY EXAMINER
TECH. CENTER 1700